REMARKS

Applicant respectfully requests reconsideration of this application in view of the following remarks. Claims 1, 8 and 15 have been amended. Claims 25-48 have been added. Claims 1, 8, 15 and 25-48 are pending. No new matter has been entered.

Applicant's attorney acknowledges the courtesies extended by the Examiner during their 2/3/2006 telephone interview. During such interview, Applicant's attorney and the Examiner discussed the rejection under 35 U.S.C. § 101. In accordance with the Examiner's suggestion, claim 15 has been amended to overcome such rejection.

Rejection of the claims

The most recent Office Action rejected claims 1, 8 and 15 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,486,895 ("Robertson").

As amended, claim 1 recites:

> 1. A method performed by a computer system, comprising:
> storing an electronic version of a paper, wherein the electronic version is displayable on a display device as a likeness of the paper; and
> in response to content of a first portion of the likeness, forming a hyperlink reference and embedding the hyperlink reference within the first portion of the likeness, wherein the hyperlink reference is associated with a second portion of the likeness, such that when the first portion of the likeness is displayed on the display device, at least a portion of the content is selectable by a user to cause the computer system to display the second portion of the likeness on the display device, and wherein the content is at least one of the following: a term that indicates a location at which the second portion of the likeness is located within the paper; and a phrase that indicates the location.

As amended, claim 8 recites:

8. A system, comprising:
a computing device for:
storing an electronic version of a paper, wherein the electronic version is displayable on a display device as a likeness of the paper; and
in response to content of a first portion of the likeness, forming a hyperlink reference and embedding the hyperlink reference within the first portion of the likeness, wherein the hyperlink reference is associated with a second portion of the likeness, such that when the first portion of the likeness is displayed on the display device, at least a portion of the content is selectable by a user to cause the computing device to display the second portion of the likeness on the display device, and wherein the content is at least one of the following: a term that indicates a location at which the second portion of the likeness is located within the paper; and a phrase that indicates the location.

As amended, claim 15 recites:

15. A computer program product stored on a tangible computer-readable medium, comprising:
a computer program processable by a computer system for causing the computer system to:
store an electronic version of a paper, wherein the electronic version is displayable on a display device as a likeness of the paper; and
in response to content of a first portion of the likeness, form a hyperlink reference and embed the hyperlink reference within the first portion of the likeness, wherein the hyperlink reference is associated with a second portion of the likeness, such that when the first portion of the likeness is displayed on the display device, at least a portion of the content is selectable by a user to cause the computer system to display the second portion of the likeness on the display device, and wherein the content is at least one of the following: a term that indicates a location at which the second portion of the likeness is located within the paper; and a phrase that indicates the location.

In MPEP § 2131, the PTO provides that:

> *"[t]o anticipate a claim, the reference must teach every element of the claim...."*

Therefore, to sustain a rejection of claim 1, Robertson must contain all of the above-recited elements in claim 1. However, Robertson fails to teach the combination of elements in amended claim 1.

For example, claim 1 recites (in part), "in response to ***content*** of a first portion of the likeness, forming a hyperlink reference and embedding the hyperlink reference within the first portion of the likeness, wherein the hyperlink reference is associated with a second portion of the likeness, such that when the first portion of the likeness is displayed on the display device, at least a portion of the ***content*** is selectable by a user to cause the computer system to display the second portion of the likeness on the display device, and wherein the ***content*** is at least one of the following: a term that indicates a location at which the second portion of the likeness is located within the paper; and a phrase that indicates the location" (emphasis added).

With respect to the "***content***" in Applicant's claim 1, the Office Action cites Robertson (at col. 6, lines 23-25), which states, "Superimposed within the horizontal scroll bars are page references 322 and 323 which indicate the page number in the book for each page." However, with respect to the page references 322 and 323, Robertson fails to teach the combination of elements in amended claim 1, and Robertson therefore fails to support a rejection of amended claim 1 under 35 U.S.C. § 102(e). In relation to amended claims 8 and 15, Robertson is likewise defective in supporting a rejection under 35 U.S.C. § 102(e).

Moreover, as stated in MPEP § 2142, "...The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness..." Also, MPEP § 2142 states: "...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made...The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'" Further, MPEP § 2143.01 states: "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination."

In relation to claim 1, Robertson is defective in establishing a prima facie case of obviousness. As between Robertson and Applicant's specification, only Applicant's specification teaches the combination of elements in amended claim 1. In fact, Robertson

teaches away from such a combination. Accordingly, the PTO's burden of factually supporting a prima facie case of obviousness has not been met.

In relation to amended claims 8 and 15, Robertson is likewise defective in establishing a prima facie case of obviousness.

Thus, a rejection of amended claims 1, 8 and 15 is not supported.

Conclusion

For these reasons, and for other reasons clearly apparent, Applicant respectfully requests allowance of claims 1, 8 and 15.

Dependent claims 25-32 depend from and further limit claim 1 and therefore are allowable.

Dependent claims 33-40 depend from and further limit claim 8 and therefore are allowable.

Dependent claims 41-48 depend from and further limit claim 15 and therefore are allowable.

To the extent that this Response to Office Action results in additional fees, the Commissioner is authorized to charge deposit account no. 50-3524.

An early formal notice of allowance of claims 1, 8, 15 and 25-48 is requested.

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Docket No. 1005.7
Customer No. 53953

Applicant has made an earnest attempt to place this case in condition for allowance. If any unresolved aspect remains, the Examiner is invited to call Applicant's attorney at the telephone number listed below.

Respectfully submitted,

Michael A. Davis, Jr.
Registration No. 35,488

Date: February 28, 2006
Davis Law Group, P.C.
9020 N. Capital of Texas Hwy.
Bldg. 1, Suite 375
Austin, Texas 78759
Telephone 512-306-8324
Facsimile 512-306-8374
Docket Number: 1005.7

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